

REMARKS

Claims 1-40 are pending in this application. Claims 1, 6, 15, 18, 28, and 31 are independent. In light of the remarks made herein, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections.

In the outstanding Official Action, the Examiner rejected claims 6-7, 31-33, 36, and 40 under 35 U.S.C. § 103(a) as being unpatentable over *Raviv et al.* (USP 6,061,052) in view of *Sekendur* (USP 5,852,434); rejected claims 1-3, 5, 8-10, 15-24, 26-30, 34-35, and 37-39 under 35 U.S.C. § 103(a) as being unpatentable over *Raviv et al.* and *Sekendur*, and further in view of *More et al.* (USP 5,194,852); rejected claim 4 under 35 U.S.C. § 103(a) as being unpatentable over *Raviv et al.*, *Sekendur*, and *More et al.*, and further in view of *Allard et al.* (USP 5,815,142); rejected claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over *Raviv et al.* and *Sekendur*, and further in view of *Weinmann et al.* ("Photoshop 5.5 for Windows and Macintosh"); and rejected claim 25 under 35 U.S.C. § 103(a) as being unpatentable over *Raviv et al.*, *Sekendur*, and *More et al.* and further in view of *Weinmann et al.* Applicants respectfully traverse these rejections.

Examiner Interview

Applicants wish to thank the Examiner for the telephonic interview conducted on September 17, 2004. It is respectfully submitted that the comments made herein memorialize the discussion

had during the telephonic interview. In light of the arguments contained herein, and based upon the agreement made during the telephonic interview, Applicants respectfully request that the Examiner reconsider and withdraw the outstanding rejections.

Claim Rejections - 35 U.S.C. § 103

In support of the Examiner's rejection of claim 6, the Examiner relies on two independent embodiments of the Raviv reference. First, the Examiner relies on the embodiment depicted in Fig. 9, which is directed to a CRT pointing system in which "highly accurate" vertical and horizontal positioning is created by patterns provided on the CRT. The Examiner relies on this embodiment to assert the teachings of a pattern unambiguously representing positions on the surface sensed by the pen.

The Examiner then switches to a separate and independent embodiment depicted in Figs. 12-14 without explanation. The embodiment depicted in Figs. 12-14 has nothing to do with unambiguously sensing pen position. Instead, in this embodiment, the pen senses the position within the cursor of Fig. 13. When the pen senses the C-portion of the cursor, the cursor is not moved. When the pen senses one of the other portions of the cursor (e.g., E, NE, N), a Δx and/or a Δy position is added or subtracted to the cursor to move the cursor under control of the pen. This is an embodiment relatively unrelated to the embodiment of Figs. 10 and 11.

In order to sustain a rejection under 35 U.S.C. § 103(a), it is respectfully submitted that the Examiner must meet his burden to establish a *prima facie* case. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations." *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In order for a *prima facie* case to exist, the prior art must suggest the desirability of the claimed invention, providing motivation to make the combination proposed by the examiner. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998). The level of skill in the art cannot be relied upon to provide this suggestion to combine the references. *Al-site Corp. v. VSI Int'l, Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

In the instant rejection, the Examiner fails to assert and further lacks any motivation to combine the teachings set forth in separate and independent embodiments as disclosed by Raviv.

Additionally, if the proposed modification or combination of the prior art would change the principal operation of the prior art invention being modified, then the teachings of the reference are

not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 439 (CCPA 1959).

The Examiner relies on different coding patterns of different regions of the cursor of Fig. 13 as the visually distinct first and second areas. The Examiner further relies on the position coding pattern of Figs. 10 and 11. The Examiner has provided no explanation as to why these aspects are combinable together. This may be because there is no motivation to combine these teachings. Assuming, *arguendo*, that these teachings are combinable, the principal operation of one embodiment would not only be changed, but destroyed when combined with the teachings of the other embodiment. As such, it is respectfully submitted that the combination of the two embodiments of the Raviv reference as asserted by the Examiner is completely improper. It is respectfully requested that the outstanding rejection be withdrawn.

As the Examiner relies on the combination of these two independent embodiments in support of his rejection of all of the independent claims, for the reasons set forth above with regard to claim 6, it is respectfully submitted that this combination of the independent embodiments disclosed in Raviv is improper, and, as such, it is respectfully submitted that claims 1, 15, 18, 21, and 31, together with claims dependent thereon, are allowable.

Conclusion

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Catherine M. Voisinet (Reg. No. 52,327) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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